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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,687	02/17/2006	Norbert Heimburger	064781505	2787
22852	7590	06/18/2007	EXAMINER FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413	
			KIM, TAEYOON	
			ART UNIT 1651	PAPER NUMBER
			MAIL DATE 06/18/2007	
			DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/568,687	HEIMBURGER ET AL.
	Examiner	Art Unit
	Taeyoon Kim	1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 March 2007.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 9-11 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 9 and 17 is/are rejected.
- 7) Claim(s) 10,11,18 and 19 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 March 2007 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's amendment and response filed on Mar. 28, 2007 has been received and entered into the case.

Claims 1-8, 12-16 and 20-35 are canceled, claims 9-11 and 17-19 are pending and have been considered on the merits. All arguments have been fully considered.

### ***Drawings***

The drawings were received on Mar. 28, 2007. These drawings are accepted.

### ***Response to Arguments***

The claim rejection made to claims 7-22 under 35 U.S.C. §112 is withdrawn due to the amendment. It is noted that the incorrect claim number was inadvertently listed in the previous office action. It was meant to be claims 7-15 as applicant pointed out. The limitation of "caused by at least one of a virus and a bacterium" has been interpreted as one or more bacterium, one or more virus, or one or more bacterium and virus for further examination.

The claim rejection made to claims 7, 8, 13, 14, 16, 21 and 22 under 35 U.S.C. §102(b) is withdrawn due to the amendment.

The claim rejections made to claims 12, 15 and 20 under 35 U.S.C. §103(a) are now withdrawn due to the amendment.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Caliezi et al. (2000) in light of Evans et al. (1979).

Claims 9 and 17 are drawn to a method of treating an infection caused by a bacterium comprising administering to a subject an effective amount of a composition comprising C1 esterase inhibitor (C1-INH), wherein the bacterium comprises at least hemagglutinin or neuraminidase (claim 9); a method of modulating an immune response to a bacterium comprising administering to a subject comprising C1-INH, wherein the bacterium comprises at least one of hemagglutinin or neuraminidase (claim 17).

Caliezi et al. teach a method of treating septic shock caused by an acute infection by *E. coli* or *Salmonella typhimurium* comprising administering C1-INH (see Table 2 at p.102).

Caliezi et al. do not teach that the *E. coli* or *Salmonella typhimurium* comprises hemagglutinin or neuraminidase. However, it is inherent property that *E. coli* expresses hemagglutinin as evidenced by Evans et al. (1979).

Since C1-INH has anti-inflammatory activity as taught by Caliezi et al. (p. 92), the administration of C1-INH to a subject would have inherently modulated an immune response caused by the bacterial infection.

M.P.E.P. §2112 states that “[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer.”

Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). >In *In re Crish*, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004), the court held that the claimed promoter sequence obtained by sequencing a prior art plasmid that was not previously sequenced was anticipated by the prior art plasmid which necessarily possessed the same DNA sequence as the claimed oligonucleotides. The court stated that "just as the discovery of properties of a known material does not make it novel, the identification and characterization of a prior art material also does not make it novel." Therefore, a holding of anticipation is clearly required.

Thus, the reference anticipates the claimed subject matter.

#### ***Allowable Subject Matter***

Claims 10, 11, 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taeyoon Kim whose telephone number is 571-272-9041. The examiner can normally be reached on 8:00 am - 4:30 pm ET (Mon-Fri).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Taeyoon Kim  
Patent Examiner  
Art Unit 1651



Leon B. Lankford, Jr  
Primary Examiner  
Art Unit 1651